

87 -4 91

Supreme Court, U.S.

FILED

SEP 19 1987

No. 87-.....

JOSEPH F. SPANIOL, JR.
CLERK

In The
Supreme Court of the United States

October Term, 1987

— 0 —
JOHN T. WILLIAMS; MCA INC.; UNIVERSAL CITY
STUDIOS.; MUSIC CORPORATION OF AMERICA;
INC.; MCA RECORDS, INC.; and MERCHANDISING
CORPORATION OF AMERICA, INC.,

Petitioners,

vs.

LESLIE T. BAXTER,

Respondents.

— 0 —
**ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

— 0 —
**APPENDIX TO PETITION FOR WRIT
OF CERTIORARI**

— 0 —
RONALD S. ROSEN
(Counsel of Record)
MARSHA E. DURKO
SILVERBERG, ROSEN, LEON
& BEHR
2029 Century Park East
Suite 1900
Los Angeles, CA 90067-3274
(213) 277-4500

*Attorneys for Petitioner
John T. Williams*

LOUIS P. PETRICH
(Counsel of Record)
EDWARD A. RUTTENBERG
LEOPOLD, PETRICH & SMITH
A Professional Corporation
2049 Century Park East
Suite 3100
Los Angeles, CA 90067-3274
(213) 277-3333

*Attorneys for Petitioners
MCA Inc., Universal City
Studios, Music Corporation
of America Inc.,
MCA Records, Inc.
Merchandising Corporation
of America, Inc.*

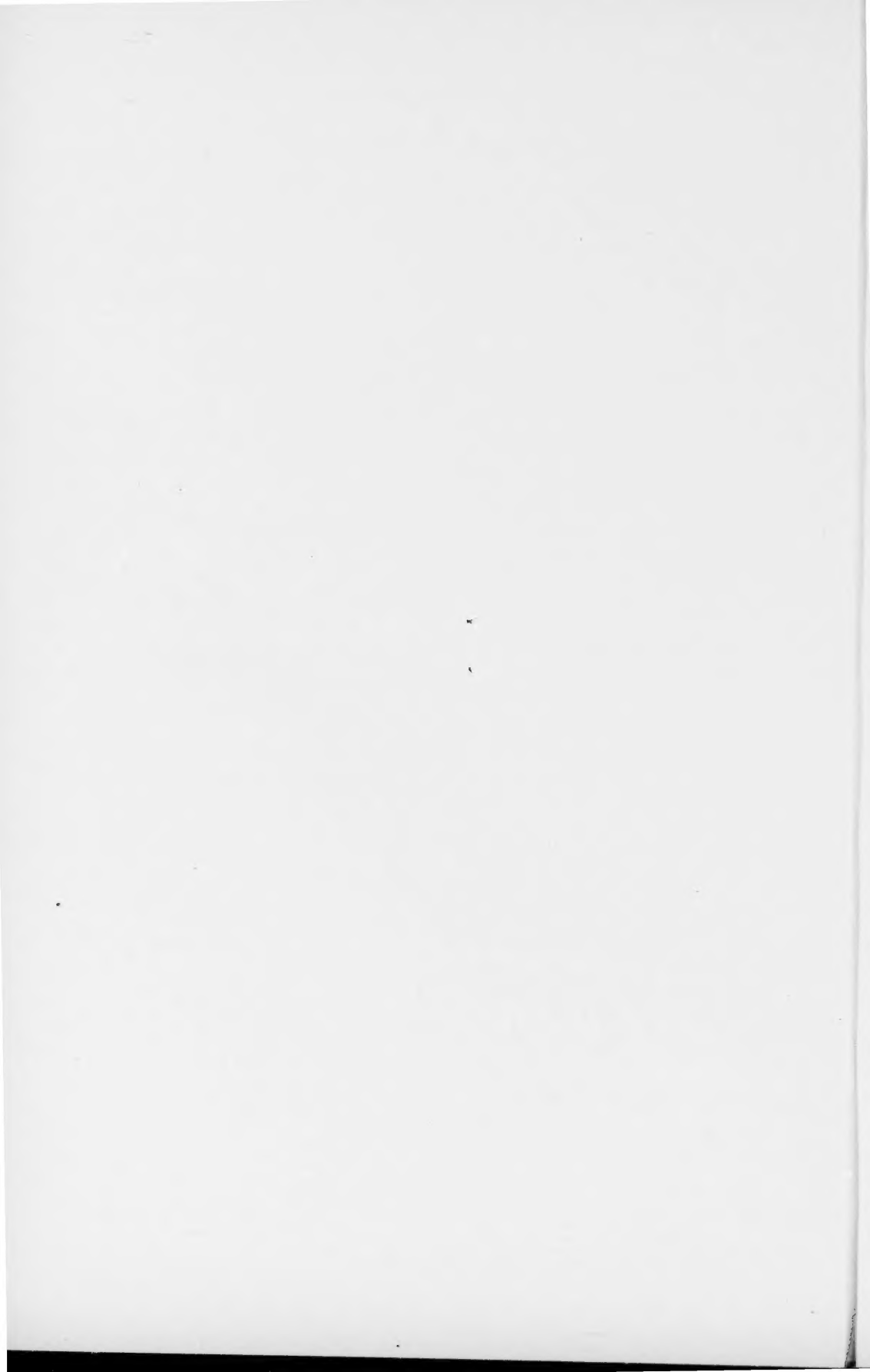
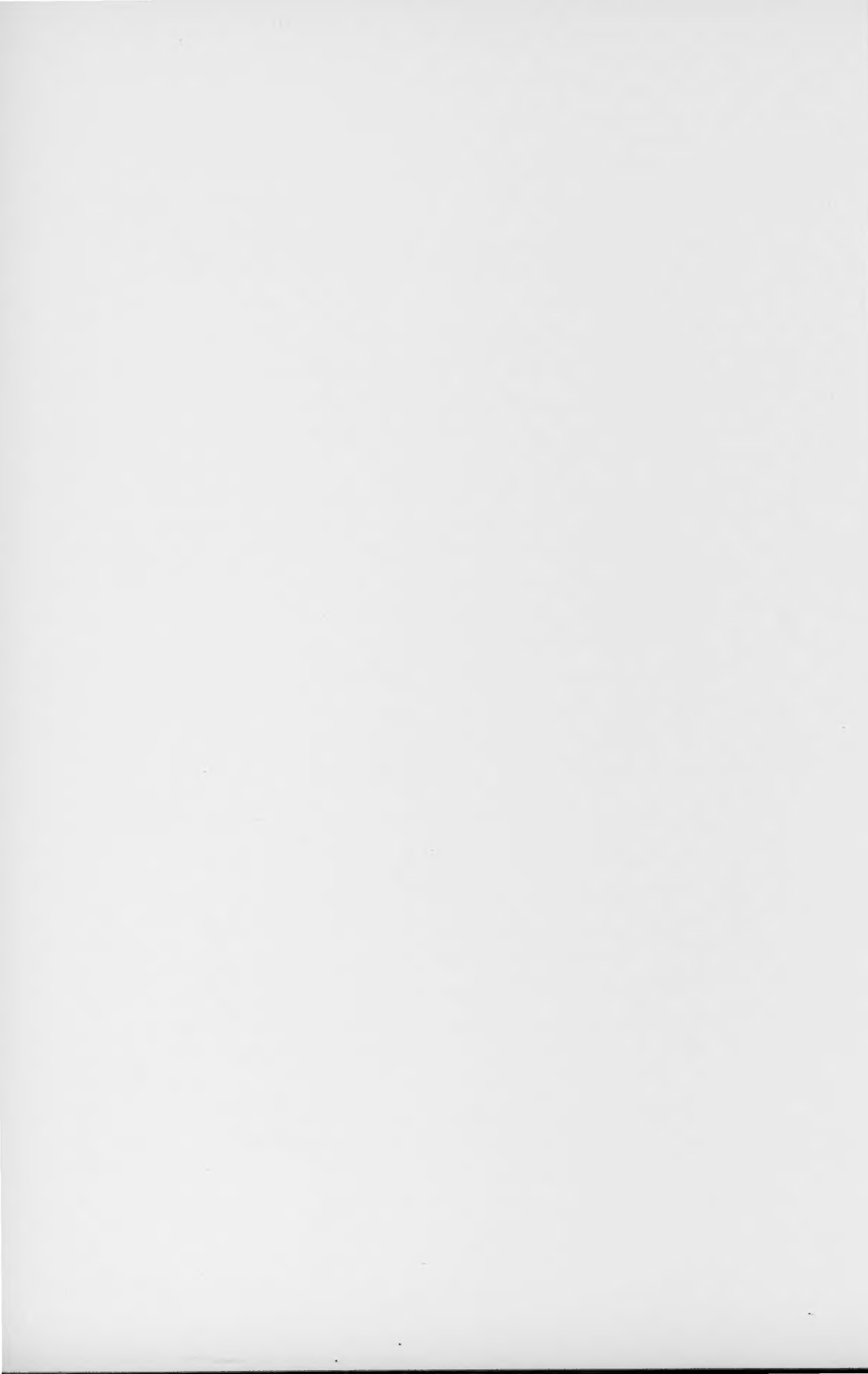


TABLE OF CONTENTS

	Page
1. Order and Amended Opinion of Ninth Circuit Court of Appeals, filed May 11, 1987, in <i>Baxter v. MCA</i>	1
2. Initial Opinion of Ninth Circuit Court of Appeals in <i>Baxter v. MCA</i> , filed March 5, 1987	13
3. Order Granting Motion For Summary Judgment, by District Court in <i>Baxter v. MCA</i> , entered October 24, 1984	26
4. Order By Ninth Circuit Court of Appeals Denying Petition For Rehearing and Suggestion For Rehearing En Banc, in <i>Baxter v. MCA</i> , filed June 23, 1987	28
5. Petition For Rehearing En Banc in <i>Baxter v. MCA</i> , filed March 19, 1987	29
6. Constitutional Provisions, Statutes and Rules Involved	48
(a) Article I, section 8 of the Constitution	48
(b) First Amendment to the Constitution	48
(c) Section 102(a) of the Copyright Act of 1976 ...	48
(d) Section 102(b) of the Copyright Act of 1976 ...	48
(e) Federal Rule of Civil Procedure 56	49
7. Order Amending Opinion, filed May 6, 1983, by Ninth Circuit Court of Appeals in <i>Twentieth Century Fox v. MCA</i>	52
8. Minute Order, filed June 22, 1987 of Central District of California in <i>Interaction Research, Inc. v. Air Cal, Inc.</i>	53
9. Memorandum, filed June 11, 1987 by Ninth Circuit Court of Appeals in <i>Thompson v. Richie</i>	55



APPENDIX

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

LESLIE T. BAXTER,
Plaintiff-Appellant,

v.

MCA, Inc., a Delaware
corporation; UNIVERSAL CITY
STUDIOS, Inc., a Delaware
corporation, MUSIC CORPORATION
OF AMERICA, a California
corporation; MCA Records, Inc.,
a California corporation;
MERCHANDISING CORPORATION OF
AMERICA, a California corporation;
and JOHN T. WILLIAMS,

No. 84-6522

D.C. No.
CV 83-7081 HLH
ORDER AND
AMENDED
OPINION

Defendants-Appellees.

Argued and Submitted
October 9, 1985—San Francisco, California

Filed March 5, 1987
Amended May 11, 1987

Before: Thomas Tang, Robert Boochever and
Alex Kozinski*, Circuit Judges.

Opinion by Judge Tang

*Judge Duniway, since deceased, was a member of the panel that originally heard oral argument in this case. Judge Kozinski was chosen by lot to replace Judge Duniway on the panel, and has had the benefit of listening to the tapes of oral argument, as well as reading the briefs and reviewing the record and exhibits in his consideration of the case.

Appeal from the United States District Court
for the Central District of California
Harry L. Hupp, District Judge, Presiding

SUMMARY

Copyright, Patent and Trademark

Appeal from a district court's grant of summary judgment in a copyright action. Reversed and remanded.

Appellant Leslie Baxter (Baxter) composed the song "Joy" in 1953, and is sole owner of all rights in the song. Defendant John Williams (Williams) was acquainted with Baxter and with the song. In 1982, Williams composed the Theme from E.T., which was used by the other defendants in a motion picture, sound recordings and merchandising. Baxter filed a complaint for copyright infringement and demand for jury trial in district court, alleging the Theme from E.T. was largely copied from Joy. The defendants moved for summary judgment on the ground that, as a matter of law, Theme from E.T. was not substantially similar to protectable expression in Joy, and therefore did not infringe it. For purposes of the motion the issues of ownership of Joy, access to the song, and similarity of the "general ideas" was conceded. The district court granted, stating that similarity was totally lacking and could not be submitted to a jury.

[1] The district court's grant of summary judgment to the defendants must be affirmed if reasonable minds could not differ as to the presence or absence of substantial similarity of expression. [2] Since many issues were conceded for purposes of the summary judgment motion, the only question before the court is whether the district court's finding, based on its ear, that substan-

tial similarity of expression was “totally lacking and could not be submitted to a jury” can sustain a judgment to the defendants. [3] Summary judgment cannot be granted if there exists a genuine dispute as to a material fact, [4] and determinations of substantial similarity of expression are subtle and complex. [5] Based on a review of the record, the court is convinced that reasonable minds could differ as to whether the songs are substantially similar.

[6] To accept the defendants’ argument that the similarity can be reduced to a six-note sequence which cannot be copyrighted would be to ignore the fundamental notion that no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity. The ear of the court must yield to the ears of jurors. Evidence that the sequence is found in other works would be admissible to rebut an inference of copying (because it would show that the sequence is so common that the probability of independent, coincidental creation was high), [7] but Baxter’s claim does not center on one six-note sequence. [8] The district court erred in granting the defendants’ motion for summary judgment.

COUNSEL

John T. Blanchard, Los Angeles, California, for the plaintiff-appellant.

Louis P. Petrich, Los Angeles, California, for the defendants-appellees, MCA, et al.

Ronald S. Rosen, Los Angeles, California, for the defendant-appellee, John T. Williams.

ORDER

The opinion filed March 5, 1987 is hereby amended as follows: (1) at slip op. page 9, delete the paragraph numbered 5, and last sentence and citation in the paragraph numbered 6; (2) at slip op. page 10, delete the first full paragraph numbered 7.

It is so ordered.

OPINION

TANG, Circuit Judge:

In this copyright infringement action, plaintiff-appellant Leslie T. Baxter appeals the district court's grant of summary judgment to John Williams and the other defendants-appellees. The district court granted defendants' motion based upon its determination that no substantial similarity of expression existed as between Baxter's copyrighted song **Joy** and the theme from the motion picture "E.T.: The Extra-Terrestrial" [hereinafter cited as **Theme from E.T.**]. We reverse the grant of summary judgment and remand for trial.

FACTS AND PROCEDURAL HISTORY

In 1953, Leslie Baxter composed a collection of seven songs intended to invoke or represent emotions. These songs were recorded and published by Capitol Records in 1954 on an album entitled **The Passions**. **Joy**, one of the compositions on that album, is the subject of this action.¹

¹Since **Joy** was published and fixed in a sound recording prior to February 15, 1972, it was not eligible for copyright registration. Baxter's claim rests on **Joy** as registered sheet music which was copyrighted on February 8, 1954 and renewed on August 20, 1982.

Baxter is the sole owner of all right, title and interest in the copyright to **Joy**.

Baxter and John Williams, a successful composer and conductor of music, have been personally acquainted for several decades. Williams had previously played the piano for Baxter at a number of recording sessions, and had knowledge of **Joy**. He participated as the pianist in the orchestra for a public performance of **Joy** in the Hollywood Bowl in the 1960s. In 1982, Williams composed **Theme from E.T.** for which he received an Academy Award for best original music. The other appellees utilized **Theme from E.T.** in the motion picture "E.T.: The Extra-Terrestrial," sound recordings and merchandising.

On November 2, 1983, Baxter filed a complaint for copyright infringement and demand for jury trial in district court. He alleged that **Theme from E.T.** was largely copied from his copyrighted song **Joy**. On September 17, 1984, defendants moved for summary judgment on the ground that, as a matter of law, **Theme from E.T.** was not substantially similar to protectible expression in **Joy**, and therefore did not infringe it. For the limited purpose of the summary judgment motion only, defendants conceded that: (1) Baxter owned a duly registered copyright in **Joy**; (2) Williams had "access" to **Joy** before the creation of **Theme from E.T.**; and (3) the "general ideas" in the subject songs were substantially similar.

Defendants attached to their motion papers the following items: (1) cassette tape recordings of **Joy** as it appeared on the album **The Passions** and the movie soundtrack of **Theme from E.T.**, (2) the twenty-three page written instrumental sheet music of **Joy** that was copyrighted;

and (3) the five page piano score of **Theme from E.T.** Baxter introduced into evidence expert testimony and five comparison tapes by Professor Harvey Bacal regarding the degree of similarity between the two compositions.

After reviewing the submitted evidence, the district court granted defendants' motion for summary judgment, stating:

This Court's "ear" is as lay as they come. The Court cannot hear any substantial similarity between defendant's expression of the idea and plaintiff's. Until Professor Bacal's tapes were listened to, the Court could not even tell what the complaint was about. Granted that Professor Bacal's comparison exposes a musical similarity in sequence of notes which would, perhaps, be obvious to experts, the similarity of expression (or impression as a whole) is totally lacking and could not be submitted to a jury.

Baxter timely appealed.

II. STANDARD OF REVIEW

[1] After the defendants stipulated to the plaintiff's ownership of the copyright and access to his work, the district court ruled as a matter of law that there was no substantial similarity between the two works. That holding is subject to our *de novo* review. *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985), *cert. denied*, — U.S. —, 106 S. Ct. 85 (1985). We review the evidence and the inferences therefrom in the light most favorable to the non-moving party, and determine whether there exists any genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *RFD Publications, Inc. v. Oregonian Pub. Co.*, 749 F.2d 1327, 1328 (9th Cir. 1984) *accord Twentieth Century Fox Film Corp. v. MCA*, 715

F.2d 1327, 1328 (9th Cir. 1983). The district court's grant of summary judgment to the defendants must be affirmed if reasonable minds could not differ as to the presence or absence of substantial similarity of expression. *See v. Durang*, 711 F.2d 141 (9th Cir. 1983). *See also Twentieth Century-Fox*, 715 F.2d at 1329.

DISCUSSION

[2] To establish a successful claim for copyright infringement, the plaintiff must prove (1) ownership of the copyright, and (2) "copying" of protectible expression by the defendant. *See Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977) (citing *Reyher v. Children's Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976), *cert. denied*, 429 U.S. 980 (1976); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975), *cert. denied*, 423 U.S. 863 (1975); 2 M. Nimmer, *Nimmer on Copyright* § 141 at 610-611 (1979) [hereinafter cited as "Nimmer"]). Because direct evidence of copying is rarely available, a plaintiff may establish copying by circumstantial evidence of: (1) defendant's access to the copyrighted work prior to the creation of defendant's work, and (2) substantial similarity of both general ideas and expression between the copyrighted work and the defendant's work. *See Krofft*, 562 F.2d at 1162. Absent evidence of access, a "striking similarity" between the works may give rise to a permissible inference of copying. *See Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984); *Shultz v. Holmes*, 264 F.2d 942 (9th Cir. 1959); Nimmer § 13.02[B] at 13-14 (1986). Baxter's ownership of the copyright to **Joy** is undisputed, and defendants conceded access for the purpose of their summary

judgment motion. Defendants further assumed for purposes of their motion that there was substantial similarity of ideas as between the two compositions. Therefore, the only question² before us is whether the district court's finding, based on its ear, that substantial similarity of expression was "totally lacking and could not be submitted to a jury," can sustain a grant of summary judgment to the defendants.

[3] Summary judgment cannot be granted if there exists a genuine dispute as to a material fact. Fed. R. Civ. P. 56(e). Rule 56 calls for the judge to determine whether there exists a genuine issue for trial, not to weigh the evi-

²Baxter argues that he should also have been permitted to prove copyright infringement by way of expert testimony and analytic dissection which allegedly demonstrated the two works' "striking similarity." This contention misapprehends the nature of the "striking similarity" doctrine. Proof of striking similarity is an alternative means of proving "copying" where proof of access is absent. See *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984); *Nimmer* § 13.02[B] at 13-14, 13-15 (1986). Yet here, access was conceded and is thus not in issue. It was thus unnecessary to consider the possibility that *Theme from E.T.* was the product of independent creation, coincidence, a prior common source, or any source other than copying. See *id.* Upon remand, however, Baxter's expert testimony and analytic dissection offered as to "striking similarity" would certainly merit submission to a jury as to the substantial similarity of general ideas as between the two works. See *Krofft*, 562 F.2d at 1164.

Baxter further contends that judicial protection beyond the "lay audience" test is required for authors of works in technical fields such as music because an infringer can easily deceive the unsophisticated by immaterial variations in the copyrighted work. It is unnecessary to reach this issue, given our holding that the grant of summary judgment constituted reversible error. No compelling reason appears, however, to depart from the principles enunciated in *Krofft*, which reiterates that the test of substantial similarity depends upon the response of the ordinary lay listener. See *Krofft*, 562 F.2d at 1164.

dence himself and determine the truth of the matter. *See Anderson v. Liberty Lobby, Inc.*, — U.S. —, 106 S. Ct. 2505, 2516 (1986). The non-moving party must present evidence sufficient to require a jury or judge to resolve the parties' differing versions of the truth at trial. *First National Bank of Arizona v. Cities Service Co.*, 391 U.S. 253, 288-289 (1968). Inferences to be drawn from facts contained in the moving party's papers are to be viewed by the district court in the light most favorable to the non-moving party. *See Adickes v. S.H. Kress & Co.*, 398 U.S. 144 (1970). Weighing evidence, determining credibility, and drawing inferences from facts remain jury functions which may not be undertaken by the trial judge. *See Anderson*, 106 S. Ct. at 2513.

[4] Determinations of substantial similarity of expression are subtle and complex. The test to be applied has been labeled an "intrinsic" one by this Court in that it depends not upon external criteria, but instead upon the response of the ordinary reasonable person to the works. *Krofft*, 562 F.2d at 1164. "Analytic dissection" and expert testimony are not called for; the gauge of substantial similarity is the response of the ordinary lay hearer. *Id.*, quoting *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *cert. denied*, 330 U.S. 851 (1947). Accordingly, in *Krofft*, this Court rejected extrinsic analysis of similarities and differences among characters in plaintiff's television show and defendants' TV commercials, in favor of asking whether the defendants' works captured the total concept and feel of plaintiffs' works. *Krofft*, 562 F.2d at 1167. *See also Berkic*, 761 F.2d at 1292; *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984), *cert. denied*, — U.S. —, 105 S. Ct. 1753 (1985); *Overman v. Universal*

City Studios, Inc., 605 F.Supp. 350, 353 (C.D. Cal. 1984), *aff'd mem.*, No. 84-6009 (9th Cir. July 2, 1985).

[5] We do not suggest that our ears are any more sophisticated than those of the district court. Nevertheless, based on our review of the record, we are persuaded that reasonable minds could differ as to whether **Joy** and **Theme from E.T.** are substantially similar. As in *Twentieth Century-Fox*, we do not suggest that the works are, in fact, substantially similar. We only state that reasonable minds could differ as to the issue and thus that summary judgment was improper. *See Twentieth-Century-Fox*, 715 F.2d at 1329.

We finally address defendants' contention that any similarity between the works can be reduced to a six-note sequence which is not protectible expression under the copyright laws. We disagree.

[6] Even were we to accept *arguendo* defendants' argument over Baxter's response that it is not a six-note sequence but the entire work whose similarity is at issue, this argument ignores the fundamental notion that no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity. *See generally* 3 M. Nimmer, Nimmer on Copyright § 13.03[A][2] (1986). Here, the ear of the court must yield to the ears of jurors. *See Roy Export Co. Establishment v. CBS*, 503 F.Supp. 1137, 1145 (S.D.N.Y. 1980), *aff'd*, 672 F.2d 1095 (2d Cir. 1982), *cert. denied*, 459 U.S. 826 (1982). Even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity. *See Walt Disney Productions v. Air Pirates*,

App. 11

581 F.2d 751 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132 (1978); *Universal Pictures v. Harold Lloyd*, 162 F.2d 354 (9th Cir. 1947); *Heim v. Universal Pictures Co.*, 154 F.2d 480, 488 (single brief phrase so idiosyncratic as to preclude coincidence might suffice to show copying) (dictum); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145 (S.D.N.Y. 1924) (L. Hand, J.) (eight note "ostinato" held to infringe copyright in song). *See also Meeropol v. Nizer*, 560 F.2d 1061 (2d Cir. 1977) (words copied amounted to less than one percent of defendant's entire work; fair use), *cert. denied*, 434 U.S. 1013 (1977); *Robertson v. Batten, Barton, Durstine & Osborne, Inc.*, 146 F.Supp. 795, 798 (S.D. Cal. 1956) (portions of song used constituted element upon which popular appeal and hence commercial success depended; fair use). *See generally* Nimmer § 13.03[A][2] at 13-36, and citations therein (notion that copying of three bars from musical work can never constitute infringement is without foundation). Certainly, evidence that the sequence in question is found in other works would be admissible to rebut an inference of copying; such evidence demonstrates that the sequence is so common that the probability of independent, coincidental creation was high. *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 720 (9th Cir. 1976).

[7] But we do not understand Baxter's claim to center solely on one six-note sequence. The jury upon remand may, of course, determine that any similarity is confined to the sequence, and that the similarity is insubstantial.

CONCLUSION:

[8] Based upon our review of the record, we cannot say that **Joy** and **Theme from E.T.** are so dissimilar that

reasonable minds could not differ as to a lack of substantial similarity between them. Therefore, the district court erred in granting defendants' motion for summary judgment.

Reversed and remanded for proceedings not inconsistent with this opinion.

UNITED STATE COURT OF APPEALS
FOR THE NINTH CIRCUIT

LESLIE T. BAXTER,

Plaintiff-Appellant,

v.

MCA, Inc., a Delaware
corporation; UNIVERSAL CITY
STUDIOS, Inc., a Delaware
corporation, MUSIC CORPORATION
OF AMERICA, a California
corporation; MCA Records, Inc., a
California corporation;
MERCHANDISING CORPORATION OF
AMERICA, a California corporation;
and JOHN T. WILLIAMS,

No. 84-6522

D.C. No.
CV 83-7081 HLH

OPINION

Defendants-Appellees.

Argued and Submitted

October 9, 1985—San Francisco, California

Filed March 5, 1987

Before: Thomas Tang, Robert Boochever and
Alex Kozinski*, Circuit Judges.

Opinion by Judge Tang

*Judge Duniway, since deceased, was a member of the panel that originally heard oral argument in this case. Judge Kozinski was chosen by lot to replace Judge Duniway on the panel, and has had the benefit of listening to the tapes of oral argument, as well as reading the briefs and reviewing the record and exhibits in his consideration of the case.

Appeal from the United States District Court
for the Central District of California
Harry L. Hupp, District Judge, Presiding

SUMMARY

Copyright, Patent and Trademark

Appeal from a district court's grant of summary judgment in a copyright action. Reversed and remanded.

Appellant Leslie Baxter (Baxter) composed the song "Joy" in 1953, and is sole owner of all rights in the song. Defendant John Williams (Williams) was acquainted with Baxter and with the song. In 1982, Williams composed the Theme from E.T., which was used by the other defendants in a motion picture, sound recordings and merchandising. Baxter filed a complaint for copyright infringement and demand for jury trial in district court, alleging the Theme from E.T. was largely copied from Joy. The defendants moved for summary judgment on the ground that, as a matter of law, Theme from E.T. was not substantially similar to protectable expression in Joy, and therefore did not infringe it. For purposes of the motion the issues of ownership of Joy, access to the song, and similarity of the "general ideas" was conceded. The district court granted, stating that similarity was totally lacking and could not be submitted to a jury.

[1] The district court's grant of summary judgment to the defendants must be affirmed if reasonable minds could not differ as to the presence or absence of substantial similarity of expression. [2] Since many issues were conceded for purposes of the summary judgment motion, the only question before the court is whether the district

court's finding, based on its ear, that substantial similarity of expression was "totally lacking and could not be submitted to a jury" can sustain a judgment to the defendants. [3] Summary judgment cannot be granted if there exists a genuine dispute as to a material fact, [4] and determinations of substantial similarity of expression are subtle and complex. [5] Since substantial similarity is usually an extremely close issue of fact, summary judgment is disfavored on that issue as a general rule, although summary judgment is not barred where the works are so dissimilar that reasonable minds could not differ as to the absence of substantial similarity. [6] Based on a review of the record, the court is convinced that reasonable minds could differ as to whether the songs are substantially similar. [7] This result is appropriate in light of the concession of access, which may have lowered the quantum of proof required for a jury to find substantial similarity, had there been a trial.

[8] To accept the defendants' argument that the similarity can be reduced to a six-note sequence which cannot be copyrighted would be to ignore the fundamental notion that no bright line rule exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity. The ear of the court must yield to the ears of jurors. Evidence that the sequence is found in other works would be admissible to rebut an inference of copying (because it would show that the sequence is so common that the probability of independent, coincidental creation was high), [9] but Baxter's claim does not center on one six-note sequence. [10] The district court erred in granting the defendants' motion for summary judgment.

COUNSEL

John T. Blanchard, Los Angeles, California, for the plaintiff-appellant.

Louis P. Petrich, Los Angeles, California, for the defendants-appellees, MCA, et al.

Ronald S. Rosen, Los Angeles, California, for the defendant-appellee, John T. Williams.

OPINION

TANG, Circuit Judge:

In this copyright infringement action, plaintiff-appellant Leslie T. Baxter appeals the district court's grant of summary judgment to John Williams and the other defendants-appellees. The district court granted defendants' motion based upon its determination that no substantial similarity of expression existed as between Baxter's copyrighted song **Joy** and the theme from the motion picture "E.T.: The Extra-Terrestrial" [hereinafter cited as **Theme from E.T.**] We reverse the grant of summary judgment and remand for trial.

FACTS AND PROCEDURAL HISTORY

In 1953, Leslie Baxter composed a collection of seven songs intended to invoke or represent emotions. These songs were recorded and published by Capital Records in 1954 on an album entitled **The Passions**. **Joy**, one of the compositions on that album, is the subject of this action.¹

¹Since **Joy** was published and fixed in a sound recording prior to February 15, 1972, it was not eligible for copyright registration. Baxter's claim rests on **Joy** as registered sheet music which was copyrighted on February 8, 1954 and renewed on August 20, 1982.

Baxter is the sole owner of all right, title and interest in the copyright to **Joy**.

Baxter and John Williams, a successful composer and conductor of music, have been personally acquainted for several decades. Williams had previously played the piano for Baxter at a number of recording sessions, and had knowledge of **Joy**. He participated as the pianist in the orchestra for a public performance of **Joy** in the Hollywood Bowl in the 1960s. In 1982, Williams composed **Theme from E.T.** for which he received an Academy Award for best original music. The other appellees utilized **Theme from E.T.** in the motion picture "E.T.: The Extra-Terrestrial," sound recordings and merchandising.

On November 2, 1983, Baxter filed a complaint for copyright infringement and demand for jury trial in district court. He alleged that **Theme from E.T.** was largely copied from his copyrighted song **Joy**. On September 17, 1984, defendants moved for summary judgment on the ground that, as a matter of law, **Theme from E.T.** was not substantially similar to protectible expression in **Joy**, and therefore did not infringe it. For the limited purpose of the summary judgment motion only, defendants conceded that: (1) Baxter owned a duly registered copyright in **Joy**; (2) Williams had "access" to **Joy** before the creation of **Theme from E.T.**; and (3) the "general ideas" in the subject songs were substantially similar.

Defendants attached to their motion papers the following items: (1) cassette tape recording of **Joy** as it appeared on the album **The Passions** and the movie soundtrack of **Theme from E.T.**, (2) the twenty-three page written instrumental sheet music of **Joy** that was copyrighted;

and (3) the five page piano score of **Theme from E.T.** Baxter introduced into evidence expert testimony and five comparison tapes by Professor Harvey Bacal regarding the degree of similarity between the two compositions.

After reviewing the submitted evidence, the district court granted defendants' motion for summary judgment, stating:

This Court's "ear" is as lay as they come. The Court cannot hear any substantial similarity between defendant's expression of the idea and plaintiff's. Until Professor Bacal's tapes were listened to, the Court could not even tell what the complaint was about. Granted that Professor Bacal's comparison exposes a musical similarity in sequence of notes which would, perhaps, be obvious to experts, the similarity of expression (or impression as a whole) is totally lacking and could not be submitted to a jury.

Baxter timely appealed.

II. STANDARD OF REVIEW

[1] After the defendants stipulated to the plaintiff's ownership of the copyright and access to his work, the district court ruled as a matter of law that there was no substantial similarity between the two works. That holding is subject to our *de novo* review. *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985), *cert. denied*, — U.S. —, 106 S. Ct. 85 (1985). We review the evidence and the inferences therefrom in the light most favorable to the nonmoving party, and determine whether there exists any genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *RFD Publications, Inc. v. Oregonian Pub. Co.*, 749 F.2d 1327, 1328 (9th Cir. 1984) *accord Twentieth Century Fox Film Corp.*

v. MCA, 715 F.2d 1327, 1328 (9th Cir. 1983). The district court's grant of summary judgment to the defendants must be affirmed if reasonable minds could not differ as to the presence or absence of substantial similarity of expression. *See v. Durang*, 711 F.2d 141 (9th Cir. 1983). *See also Twentieth Century-Fox*, 715 F.2d at 1329.

DISCUSSION

[2] To establish a successful claim for copyright infringement, the plaintiff must prove (1) ownership of the copyright, and (2) "copying" of protectible expression by the defendant. *See Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977) (citing *Reyher v. Children's Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976), *cert. denied*, 429 U.S. 980 (1976); *Universal Athletic Sales Co. v. Sal-keld*, 511 F.2d 904, 907 (3d Cir. 1975), *cert. denied*, 423 U.S. 863 (1975); 2 M. Nimmer, *Nimmer on Copyright* § 141 at 610-611 (1979) [hereinafter cited as "Nimmer"]). Because direct evidence of copying is rarely available, a plaintiff may establish copying by circumstantial evidence of: (1) defendant's access to the copyrighted work prior to the creation of defendant's work, and (2) substantial similarity of both general ideas and expression between the copyrighted work and the defendant's work. *See Krofft*, 562 F.2d at 1162. Absent evidence of access, a "striking similarity" between the works may give rise to a permissible inference of copying. *See Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984); *Shultz v. Holmes*, 264 F.2d 942 (9th Cir. 1959); Nimmer § 13.02[B] at 13-14 (1986). Baxter's ownership of the copyright to **Joy** is undisputed, and defendants conceded access for the purpose of their sum-

mary judgment motion. Defendants further assumed for purposes of their motion that there was substantial similarity of ideas as between the two compositions. Therefore, the only question² before us is whether the district court's finding, based on its ear, that substantial similarity of expression was "totally lacking and could not be submitted to a jury," can sustain a grant of summary judgment to the defendants.

[3] Summary judgment cannot be granted if there exists a genuine dispute as to a material fact. Fed. R. Civ. P. 56(c). Rule 56 calls for the judge to determine whether there exists a genuine issue for trial, not to weigh the evidence himself and determine the truth of the mat-

²Baxter argues that he should also have been permitted to prove copyright infringement by way of expert testimony and analytic dissection which allegedly demonstrated the two works' "striking similarity." This contention misapprehends the nature of the "striking similarity" doctrine. Proof of striking similarity is an alternative means of proving "copying" where proof of access is absent. See *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984); *Nimmer* § 13.02[B] at 13-14, 13-15 (1986). Yet here, access was conceded and is thus not in issue. It was thus unnecessary to consider the possibility that **Theme from E.T.** was the product of independent creation, coincidence, a prior common source, or any source other than copying. See *id.* Upon remand, however, Baxter's expert testimony and analytic dissection offered as to "striking similarity" would certainly merit submission to a jury as to the substantial similarity of general ideas as between the two works. See *Krofft*, 562 F.2d at 1164.

Baxter further contends that judicial protection beyond the "lay audience" test is required for authors of works in technical fields such as music because an infringer can easily deceive the unsophisticated by immaterial variations in the copyrighted work. It is unnecessary to reach this issue, given our holding that the grant of summary judgment constituted reversible error. No compelling reason appears, however, to depart from the principles enunciated in *Krofft*, which reiterates that the test of substantial similarity depends upon the response of the ordinary lay listener. See *Krofft*, 562 F.2d at 1164.

ter. *See Anderson v. Liberty Lobby, Inc.*, — U.S. —, 106 S.Ct. 2505, 2516 (1986). The non-moving party must present evidence sufficient to require a jury or judge to resolve the parties' differing versions of the truth at trial. *First National Bank of Arizona v. Cities Service Co.*, 391 U.S. 253, 288-289 (1968). Inferences to be drawn from facts contained in the moving party's papers are to be viewed by the district court in the light most favorable to the non-moving party. *See Adickes v. S. H. Kress & Co.*, 398 U.S. 144 (1980). Weighing evidence, determining credibility, and drawing inferences from facts remain jury functions which may not be undertaken by the trial judge. *See Anderson*, 106 S.Ct. at 2513.

[4] Determination of substantial similarity of expression are subtle and complex. The test to be applied has been labeled an "intrinsic" one by this Court in that it depends not upon external criteria, but instead upon the response of the ordinary reasonable person to the works. *Krofft*, 562 F.2d at 1164, "Analytic dissection" and expert testimony are not called for; the gauge of substantial similarity is the response of the ordinary lay hearer. *Id.*, quoting *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *cert. denied*, 330 U.S. 851 (1947). Accordingly, in *Krofft*, this Court rejected extrinsic analysis of similarities and differences among characters in plaintiff's television show and defendants' TV commercials, in favor of asking whether the defendants' works captured the total concept and feel of plaintiffs' works. *Krofft*, 562 F.2d at 1167. *See also Berkic*, 761 F.2d at 1292; *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984), *cert. denied*, — U.S. —, 105 S.Ct. 1753 (1985); *Overman v. Universal City Studios*,

Inc., 605 F.Supp. 350, 353 (C.D. Cal. 1984), *aff'd mem.*, No. 84-6009 (9th Cir. July 2, 1985).

[5] Since substantial similarity is usually an extremely close issue of fact, summary judgment is disfavored on that issue as a general rule. *See Berkic*, 761 F.2d at 1292; *Litchfield*, 736 F.2d at 1355-1356; *Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981), *incorporated by reference*, 698 F.2d 966 (9th Cir. 1982). By no means does this general rule bar a grant of summary judgment, however, where the works are so dissimilar that reasonable minds could not differ as to the absence of substantial similarity. *See Litchfield*, 736 F.2d at 1355-1356 (play and movie); *Beric*, 761 F.2d at 1292 (screenplay and movie); *Jason*, 698 F.2d at 967 (novel and movie); *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1330 (9th Cir. 1983) (movie and television show); *See*, 711 F.2d at 142-143 (plays); *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir. 1986) (book and movie), *cert. denied*, — U.S. —, 106 S. Ct. 2278 (1986); *Overman*, 605 F.Supp. at 354 (screenplay and movie). The question before us, then, is whether reasonable minds could differ as to the absence of substantial similarity of expression as between **Joy** and **Theme from E.T.**

[6] We do not suggest that our ears are any more sophisticated than those of the district court. Nevertheless, based on our review of the record, we are persuaded that reasonable minds could differ as to whether **Joy** and **Theme from E.T.** are substantially similar. As in *Twentieth Century-Fox*, we do not suggest that the works are, in fact, substantially similar. We only state that reasonable minds could differ as to the issue and thus that sum-

mary judgment was improper. See *Twentieth Century-Fox*, 715 F.2d at 1329. This is simply not a case in which the absence of similarities is so patent as to warrant summary judgment. See *Arnstein*, 154 F.2d at 473.

[7] The result we reach is also appropriate in light of the fact that defendants' concession of access may have lowered the quantum of proof required for a jury to find substantial similarity, had there been a trial. See *Krofft*, 562 F.2d at 1172 (degree of access justifies lower standard of proof necessary to show substantial similarity), quoting *Nimmer* § 143.4 at 634 (1976). As in *Krofft*, this case presents ample evidence of access. Defendant Williams had personal knowledge of **Joy** and participated as the pianist in the orchestra for a public performance of **Joy** in the Hollywood Bowl. In a trial, such evidence of access is relevant to substantial similarity, and merits submission to a jury.³

We finally address defendants' contention that any similarity between the works can be reduced to a six-note sequence which is not protectible expression under the copyright laws. We disagree.

[8] Even were we to accept *arguendo* defendants' argument over Baxter's response that it is not a six-note sequence but the entire work whose similarity is at issue, this argument ignores the fundamental notion that no bright line rule exists as to what quantum of similarity is

³It is clear, however, that no amount of proof of access will suffice to show copying if similarities are found to be absent. *Krofft*, 562 F.2d at 1172 (citing *Williams v. Kaag Manufacturers, Inc.*, 338 F.2d 949, 951 (9th Cir. 1964); *Arnstein*, 154 F.2d at 468).

permitted before crossing into the realm of substantial similarity. *See generally* 3 M. Nimmer, Nimmer on Copyright § 13.03[A][2] (1986). Here, the ear of the court must yield to the ears of jurors. *See Roy Export Co. Establishment v. CBS*, 503 F.Supp. 1137, 1145 (S.D.N.Y. 1980), *aff'd*, 672 F.2d 1095 (2d Cir. 1982), *cert. denied*, 459 U.S. 826 (1982). Even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity. *See Walt Disney Productions v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132 (1978); *Universal Pictures v. Harold Lloyd*, 162 F.2d 354 (9th Cir. 1947); *Heim v. Universal Pictures Co.*, 154 F.2d 480, 488 (single brief phrase so idiosyncratic as to preclude coincidence might suffice to show copying) (*dictum*); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145 (S.D.N.Y. 1924) (L. Hand, J.) (eight note "ostinato" held to infringe copyright in song). *See also Meeropol v. Nizer*, 560 F.2d 1061 (2d Cir. 1977) (words copied amounted to less than one percent of defendant's entire work; fair use), *cert. denied*, 434 U.S. 1013 (1977); *Robertson v. Batten, Barton, Durstine & Osborne, Inc.*, 146 F.Supp. 795, 798 (S.D. Cal. 1956) (portions of song used constituted element upon which popular appeal and hence commercial success depended; fair use). *See generally* Nimmer § 13.03[A][2] at 13-36, and citations therein (notion that copying of three bars from musical work can never constitute infringement is without foundation). Certainly, evidence that the sequence in question is found in other works would be admissible to rebut an inference of copying; such evidence demonstrates that the sequence is so common that the probability of independent, coincidental creation was high. *Granite Music*

Corp. v. United Artists Corp., 532 F.2d 718, 720 (9th Cir. 1976).

[9] But we do not understand Baxter's claim to center solely on one six-note sequence. The jury upon remand may, of course, determine that any similarity is confined to the sequence, and that the similarity is insubstantial.

CONCLUSION:

[10] Based upon our review of the record, we cannot say that **Joy** and **Theme from E.T.** are so dissimilar that reasonable minds could not differ as to a lack of substantial similarity between them. Therefore, the district court erred in granting defendants' motion for summary judgment.

Reversed and remanded for proceedings not inconsistent with this opinion.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

LESLIE T. BAXTER, an individual,)	NO. CV 83-7081-
)	HLH
)	
Plaintiff,)	ORDER
)	GRANTING
vs.)	MOTION FOR
)	SUMMARY
MCA, INC., ETC., et al.,)	JUDGMENT
)	
Defendants.)	(filed October
)	23, 1984)
)	
_____)	(entered October
)	24, 1984)

Defendant's motion for summary judgment, previously submitted, is granted. The revised Statement of Uncontroverted Facts, Conclusions of Law, and Judgment is signed this date. The motion to strike the jury demand is off calendar as moot.

The second branch of the *Krofft* test (*Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.* (9th Cir. 1977) 562 F.2d 1157) is whether a reasonable lay jury could find "substantial similarity" of expression of the ideas—the so-called intrinsic test. This Court's "ear" is as lay as they come. The Court cannot hear any substantial similarity between defendant's expression of the idea and plaintiff's. Until Professor Bacal's tapes were listened to, the Court could not even tell what the complaint was about. Granted that Professor Bacal's comparison exposes a musical similarity in sequence of notes which would, perhaps, be obvious to experts, the similarity

of expression (or impression as a whole) is totally lacking and could not be submitted to a jury.

Plaintiff argues that the expert's declarations show substantial evidence of "striking similarity" and, therefore, the summary judgment cannot be granted. Plaintiff misses the point of the *Krofft* case (see, also, *Arnstein v. Porter* (2d Cir. 1946) 154 F.2d 464). "Striking similarity," according to the experts, may be evidence of access (admitted for purpose of this motion), but does not address itself to the "substantial similarity" of expression to the lay listener now being considered. As to that issue, the Court does not believe that there is a jury question.

The motion for summary judgment is granted.

DATED: October 23, 1984.

/s/ Harry L. Hupp
United States District Judge

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

LESLIE T. BAXTER,)	No. 84-6522
)	D.C. # CV
Plaintiff-Appellant,)	83-7081 HLH
)	
vs.)	
)	
MCA, Inc., a Delaware)	ORDER
corporation; UNIVERSAL CITY)	DENYING
STUDIOS, Inc., a Delaware)	PETITION FOR
corporation; MUSIC CORPORATION)	REHEARING AND
OF AMERICA, a California)	SUGGESTION
corporation; MCA Records, Inc.,)	FOR REHEARING
a California corporation;)	EN BANC
MERCHANDISING CORPORATION)	
OF AMERICA, a California)	(filed June
corporation; and JOHN T.)	23, 1987)
WILLIAMS,)	
)	
Defendants-Appellees.)	
)	
)	

Before: TANG, BOOCHEVER and KOZINSKI, Circuit Judges.

The panel as constituted above has voted to deny the petition for rehearing and to reject the suggestion for rehearing en banc.

The full court has been advised of the suggestion for rehearing en banc. By the due date of May 22, 1987, no judge of the court has requested a vote on the suggestion for rehearing en banc. Fed. R. App. P. 35(b).

The petition for rehearing is denied and the suggestion for rehearing en banc is rejected.

App. 29

No. 84-6522

IN THE
UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

LESLIE T. BAXTER,

Plaintiff-Appellant,

vs.

MCA, INC., et al.,

Defendants-Appellees.

PETITION FOR REHEARING
EN BANC

(Filed March 19, 1987)

RONALD S. ROSEN
MARSHA E. DURKO
SILVERBERG, ROSEN, LEON
& BEHR
A Partnership Including
Professional Corporations
2029 Century Park East
Suite 1900
Los Angeles, California 90067
Telephone: 213/277-4500

Attorneys for Defendant-
Appellee, John T. Williams

LOUIS P. PETRICH
EDWARD A. RUTTENBERG
LEOPOLD, PETRICH & SMITH
A Professional Corporation
2049 Century Park East
Suite 3110
Los Angeles, California 90067
Telephone: 213/277-3333

Attorneys for Defendants-
Appellees, MCA Inc., Universal
City Studios, Inc., Music Corp.
of America, MCA Records, Inc.,
Merchandising Corp. of
America

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
I. INTRODUCTION	1
II. THE COURT FAILED TO DETERMINE WHETHER DEFENDANTS ARGUABLY TOOK PROTECTIBLE EXPRESSION OR WHETHER ANY TAKING WAS ARGUABLY SUBSTANTIAL UNDER THE AUDIENCE TEST	5
A. Whether Expression Was Arguably Involved	6
B. Whether Substantial Similarity of Expres- sion Arguably Existed Under the Audience Test	9
III. THE OPINION FAILS TO FOLLOW THE PROPER TESTS FOR SUMMARY JUDG- MENT ESTABLISHED BY THE SUPREME COURT, OTHER PANELS OF THIS CIRCUIT AND OTHER CIRCUIT COURTS	11
IV. CONCLUSION	14
APPENDICES:	
1. Order Amending Opinion in <i>Twentieth Cen- tury-Fox Film Corporation v. MCA, Inc.</i> , No. CA 80-5868	
2. Audio Cassettes of "Joy" and "E.T. Theme"	

TABLE OF AUTHORITIES

	Page
CASES	
<i>Adickes v. S.H. Kress & Co.</i> , 398 U.S. 144 (1970).....	5
<i>Anderson v. Liberty Lobby, Inc.</i> , 477 U.S. —, 106 S.Ct. 2505, 91 L.Ed. 2d 202 (1986)	1
<i>Arc Music Corp. v. Lee</i> , 296 F.2d 186 (1961)	10
<i>Arnstein v. Porter</i> , 154 F.2d 464 (2d Cir. 1946)	2, 5, 10, 11, 12, 13, 14
<i>Berkie v. Crichton</i> , 761 F.2d 1289 (9th Cir. 1985)	5, 7, 9, 10, 11, 12, 14
<i>Celotex Corp. v. Catrett</i> , 477 U.S. —, 106 S.Ct. 2548, 91 L.Ed. 2d 265 (1986)	1, 5, 6, 8, 13
<i>Darrell v. Joe Morris Music Co.</i> , 113 F.2d 80 (2d Cir. 1940)	7
<i>Fisher v. Dees</i> , 794 F.2d 432 (9th Cir. 1986).....	1, 9, 11, 13
<i>Granite Music Corp. v. United Artists Corp.</i> , 532 F.2d 718 (9th Cir. 1976)	7
<i>Harper & Row Publishers, Inc. v. Nation Enter- prises</i> , 471 U.S. 539 (1985)	3
<i>Hirsch v. Paramount Pictures</i> , 17 F. Supp. 816 (S.D.Calif. 1937)	7
<i>Jason v. Fonda</i> , 698 F.2d 966 (9th Cir. 1982)	11, 14
<i>Landsberg v. Scrabble Crossword Game Players, Inc.</i> , 736 F.2d 485 (9th Cir. 1984)	7, 10
<i>Litchfield v. Spielberg</i> , 736 F.2d 1352 (9th Cir. 1984)	3, 8, 10, 11, 12, 14
<i>See v. Durang</i> , 711 F.2d 141 (9th Cir. 1983)	5, 10, 11, 12, 13, 14

TABLE OF AUTHORITIES—Continued

	Page
<i>Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.</i> , 562 F.2d 1157 (9th Cir. 1977)	3, 8, 9, 10, 11, 12, 13
<i>Twentieth Century-Fox Film Corp. v. MCA, Inc.</i> , 715 F.2d 1327 (9th Cir. 1983)	11
<i>Universal Athletic Sales Co. v. Salkeld</i> , 511 F.2d 904 (3rd Cir. 1975)	10
<i>Walker v. Time Life Films, Inc.</i> , 784 F.2d 44 (2d Cir. 1986)	4, 7
<i>Warner Bros., Inc. v. American Broadcasting Cos.</i> , 654 F.2d 204 (2d Cir. 1981)	4
<i>Warner Bros., Inc. v. American Broadcasting Cos.</i> , 720 F.2d 231 (2d Cir. 1983)	2
STATUTES	
17 U.S.C. §§ 502-504	3
RULES	
Federal Rules Appellate Procedure 35(a)	1
Federal Rules Appellate Procedure 40(a)	1
Federal Rule of Civil Procedure 56 (e)	11
Ninth Circuit Local Rule 12(b)	1, 3
TREATIES	
<i>Moore's Federal Practice</i> , Volume 6 Part 2, ¶56.17 [14] (2d ed. 1985)	11
M Nimmer, <i>Nimmer On Copyright</i> , Vol. 3, § 13.03 [E] (1986)	4

Defendants-Appellees JOHN T. WILLIAMS, MCA INC., UNIVERSAL CITY STUDIOS, INC., MUSIC CORP. OF AMERICA, MCA RECORDS, INC., and MERCHANDISING CORP. OF AMERICA ("defendants") respectfully petition this Court for a rehearing of its March 5, 1987 Opinion ("Opinion"). Defendants suggest that a rehearing *en banc* is appropriate to secure or maintain uniformity of the Court's decisions and to resolve questions of exceptional importance (Fed. Rules App. Proc. 35(a)), as is more fully set forth herein.

I. INTRODUCTION

The grounds for rehearing are that: (1) material facts and law were overlooked or misapprehended in the Opinion; and (2) the Opinion is in apparent conflict with other decisions of this Court and the United States Supreme Court that were not addressed. F.R.A.P. 35(a), 40(a); Ninth Cir. Local R. 12(b).

After submission of the case for seventeen months,¹ in an Opinion by Circuit Judge Thomas Tang, joined in by Circuit Judges Robert Boochever and Alex Kozinski, the panel reversed a summary judgment that had dismissed a music copyright infringement claim against the theme music of the motion picture "E.T.: THE EXTRA-TERRESTRIAL" ("E.T. Theme") for lack of substantial similarity of protectible expression to plaintiff's song "Joy".

In the opinion of counsel a rehearing is appropriate and necessary because:

¹ Several important decisions were rendered during the interim. *Anderson v. Liberty Lobby, Inc.*, 106 S.Ct. 2505 (1986); *Celotex Corp. v. Catrett*, 106 S.Ct. 2548 (1986); *Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986).

1. The Opinion resurrects the discredited anti-summary judgment "slightest doubt" rule (restated as a "no bright line" test) of *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946)—in conflict with decisions of the Supreme Court and this Court. The effect of the Opinion is to make summary judgment for lack of substantial similarity of expression unavailable in virtually all music infringement cases—and perhaps in all other infringement cases.

2. The Opinion purports to decide that a triable issue exists regarding *substantial similarity of expression*—but overlooks or misapprehends material facts and law as to (a) whether the arguable similarities relate to unprotected ideas or protectible expression, (b) whether a jury applying the "audience test" could reasonably conclude that the "E.T. Theme" serves to fulfill the demand for plaintiff's song, "Joy," and (c) what is the appropriate function of the courts in monitoring those issues.

3. The Opinion overlooks or misapprehends material law and conflicts with prior decisions of this Court and other Circuit Courts by applying the so-called Inverse Ratio Rule to the wrong issue.

4. The total effect of the Opinion is to abdicate an important judicial responsibility²—i.e., to administer the idea/expression dichotomy—in violation of copyright policy and First Amendment considerations and in conflict

² *Warner Bros., Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 245 (2d Cir. 1983) (courts must monitor the limits within which juries may decide substantial similarity of expression).

with decisions of this Court and the United States Supreme Court.³

For the same reason, a hearing *en banc* is justified to secure or maintain uniformity of the Circuit's decisions and because the proceeding involves questions of exceptional importance. The Opinion also directly conflicts with existing opinions of other circuit courts and substantially affects rules of national application in which there is an overriding need for national uniformity. Local Rule 12(b).

The Opinion threatens to destroy an entire industry's ability to rid itself of the meritless plagiarism lawsuits attracted by virtually every successful television series, motion picture and musical composition.⁴ Unless meritless claims can be promptly dismissed, future creative effort and investment will be deterred. The lack of clear judicial guidelines will encourage strike suits,⁵ and, as a practical

³ The idea/expression dichotomy is mandated by First Amendment considerations. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985); *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1170 (9th Cir. 1977) ("*Krofft*" hereafter).

⁴ E.g., *Litchfield v. Spielberg*, 736 F.2d 1352, 1358 (9th Cir. 1984) (affirming summary judgment dismissing claim by play against "E.T." movies) (many copyright cases are premised on a wholly erroneous understanding of copyright protection).

⁵ The draconian remedies of the Copyright Act—injunctive relief, impoundment and destruction, and damages measured by defendants' profits—17 U.S.C. §§ 502-504, attract suits and afford plaintiffs considerable leverage to coerce settlements. Defendants' motion picture, "E.T.", perhaps the most successful motion picture in history, has attracted at least four (4) unsuccessful infringement actions, dismissed on motion, notably *Litchfield v. Spielberg*, *supra* (affirming summary judgment for lack of substantial similarity). Its re-release is threatened by this suit.

matter, will unduly expand the monopoly claimed by plaintiffs and force overly cautious self-censorship by defendants. Such a result defeats the purpose of the Copyright Act and impairs First Amendment rights of self-expression.

Infringement is proven by showing (1) *substantial similarity of expression* in each work (2) that resulted from defendant's *copying* of plaintiff's work. The act of copying (*derivation*) is difficult to disprove by summary judgment because an inference of copying arises upon a showing of "access" and substantial similarity either of idea or expression. 3 Nimmer, *Nimmer On Copyright* § 13.03[E] at 13-58 to 59 (1986). Access is easily shown by prior publication and distribution by mass media. Thus, "lack of *substantial similarity of expression*" (involving the dual aspects of *protectibility* and *substantiality* of the taking) presents defendants' best hope to obtain prompt dismissal⁶ and to avoid infringement in the first instance.⁷ But this hope depends upon reasonably clear guidelines carefully applied by the courts.

In the case of dramatic works—books, motion pictures and television programs—this Court has developed guidelines so that the extrinsic and intrinsic tests of infringe-

⁶ Courts may determine non-infringement as a matter of law if the similarity concerns only non-copyrightable elements (e.g., facts or ideas) or if no reasonable jury could find the two works substantially the same. *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir. 1986).

⁷ "... a defendant may legitimately avoid infringement by intentionally making sufficient changes in a work which would otherwise be regarded as substantially similar..." *Warner Bros., Inc. v. American Broadcasting Cos.*, 654 F.2d 204, 211 (2d Cir. 1981).

ment may be applied to dispose of meritless claims on motions for summary judgment. As a matter of law, no infringement exists under the intrinsic test unless a reasonable lay audience would consider defendants' work to serve as a substantial substitute for plaintiff's work. *E.g.*, *Berkic v. Crichton*, 761 F.2d 1289, 1294 (9th Cir. 1985).

On the substantive law, the Opinion fails to determine whether the arguable similarities involve protectible expression or musical ideas, fails to apply the audience test and misapplies the Inverse Ratio Rule (intended to determine *derivation*) to determine the *scope of protection*. Procedurally, in direct conflict with *Celotex Corp. v. Catrett*, 106 S.Ct. 2548 (1986), and *See v. Durang*, 711 F.2d 141 (9th Cir. 1983) the panel mischaracterizes summary judgment as "disfavored", shifts the burden of proof to defendants to show the absence of evidence to support plaintiff's claim,⁸ and resurrects the discredited "slightest doubt" rule of the *Arnstein* decision, restated as a "no bright line" test.

⁸ In *Celotex*, clarifying its earlier decision in *Adickes v. S.H. Kress & Co.*, 398 U.S. 144 (1970), the Supreme Court mandated that the non-moving party continues to bear the burden of raising genuine issues of fact regarding issues on which it has the burden of proof; the moving party has no duty to show the absence of evidence to support the non-moving party's case. 91 L.Ed. 2d at 265-66. The Opinion fails to cite *Celotex*, relies upon *Adickes* (Op. at 8) and implies (Op. at 11) that defendants failed to disprove the possibility of sufficient similarities of expression.

II. THE COURT FAILED TO DETERMINE WHETHER DEFENDANTS ARGUABLY TOOK PROTECTIBLE EXPRESSION OR WHETHER ANY TAKING WAS ARGUABLY SUBSTANTIAL UNDER THE AUDIENCE TEST

Defendants simplified the courts' task by *assuming for sake of argument* that:

1. Plaintiff owned the copyright in the song "Joy".
2. Defendants had access to plaintiff's song.

3. If any substantial similarity existed in the protectible expression in the two works, it resulted from copying by defendants (thus conceding *derivation*). All that remained for decision was whether defendants took *protectible expression* in *sufficient amounts* to constitute infringement (whether defendants' song satisfied the *demand* for plaintiff's song).

A. *Whether Expression Was Arguably Involved*

The Opinion never analyzes whether the arguable similarities⁹ involve *expression*. The panel misapprehends *defendants* to argue that a *six-note* sequence is at stake (Opinion at 10).¹⁰ It ignores *plaintiff's concession*¹¹ that

⁹ By "arguable similarities" we mean those similarities that are reasonably apparent from the works as distinguished from "claimed similarities" that are not supported by the record; the latter are irrelevant to the motion for summary judgment. *Celotex Corp.*, 106 S.Ct. 2548.

¹⁰ A musical note consists of a "pitch" [e.g., A, C, F] and a "duration" [e.g., quarter note, half note]. Plaintiff claimed that the 12-note "motif" in "Joy" was infringed by the 8-note main theme in "E.T." The pitches and rhythm of these two segments may be illustrated as follows, with the

(Continued on following page)

two segments of six notes identical only in pitch (without considering rhythm, context, and other qualities) is meaningless.¹² "Similarity of tone succession" is "inevitable in all musical compositions." *Hirsch v. Paramount Pictures*, 17 F.Supp. 816, 817 (S.D. Calif. 1937) (Yankwich, J.)

If the panel had considered defendants' contentions (note 10, *supra*) that only four successive notes in each

(Continued from previous page)

pitch of each note represented by each letter and its *duration* by the number of times the pitch is denoted between dashes. (Lower case letters represent grace notes.)

"JOY": DD-DD-DD-GG-f-g-F-E-D-E-CC-AA.

"E.T. Theme": CCCC-GGGG-F-E-D-E-CCCC-GGGG.

Defendants argued that, at most, a four-note sequence was properly compared—only a four-note sequence was identical in pitch and rhythm: F-E-D-E (underlined above) (Defts' Jt. Br. 3). Other popular songs with the same four-note sequence are: "The Star Spangled Banner," "O Holy Night," "Three Blind Mice," "God Save the Queen."

¹¹ C.R. 14, Exh. F, at 46-55. Plaintiff happily conceded that many earlier songs had musical phrases with the same 6-note sequence equal in pitch; he ridiculed its significance, pointing out that the first seven notes of "Rock Of Ages" and "Rudolph the Rednosed Reindeer" are also identical in pitch to each other. *Ibid*; Baxter Reply Br. 3-4.

¹² All music in Western society is limited to 12 pitches, reduced to 7-note major or minor scales, and reduced further still by the limited number of combinations that are pleasing to the ear. *Darrell v. Joe Morris Music Co.*, 113 F.2d 80, 82 (2d Cir. 1940). The panel's ruling that fragments of musical ideas or cliches no matter how differently used or developed may be copyrightable directly conflicts with decisions holding in literary and factual contexts that the use of ideas, cliches, scenes-a-faire and other staples of literature cannot raise a triable issue of fact. See, e.g., *Berkic v. Crichton*, 761 F.2d 1289, 1293-94 (9th Cir. 1985).

work were identical in pitch *and rhythm*, it would have had to deal with an existing precedent directly on point:

“The *copyrightability* of [the song] ‘Bubbles’ is *not* the *four note sequence* but the fitting together of this sequence with other melodious phrases into a unique composition.”

Granite Music Corp. v. United Artists Corp., 532 F.2d 718, 721 (9th Cir. 1976) (Carter, J.) (emphasis added).

The panel seems to rule that whether expression is involved (Op. 10, ¶2) depends upon the amount of the taking (Op. 10, ¶3). All authority is to the contrary. *E.g., Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 489 (9th Cir. 1984) (reversal for lack of substantial similarity of *expression* after judgment of copying); *Walker*, 784 F.2d at 49-51. The panel’s approach converts the issue of *copyrightability* into a question of *derivation*.¹³

As a backstop, the panel concludes “but we do not understand Baxter’s claim to center solely on one six-note

¹³ Both *Berkic* and *Litchfield* rejected the claim that proof of derivation without a showing that substantial amount of protectible expression proves infringement. Significantly, the cases cited as authority for the panel’s analysis of *expression* (Op. at 10-11) do not analyze whether the allegedly copied sequence constituted protectible expression, but with one exception either focus on whether the similarities indicated *derivation* (*Heim*, *Fred Fisher*) or whether the taking of conceded by protectible expression was excused by the “fair use” defense (*Walt Disney*, *Meeropol*, *Robertson*). *Harold Lloyd* ruled that copying of 57 consecutive scenes from a film constitutes infringement. The panel’s reliance on Professor Nimmer’s suggestion that copying of *three successive bars* of music *might* constitute infringement indicates a misapprehension of the facts of this case. The four note segment here is *one-half* ($1/2$) of one bar.

sequence.”¹⁴ Opinion at 11. But that cryptic comment is never explained.¹⁵ Nor, when one listens to the works (audiotapes, Appendix 2) with the correct test in mind, does comparison of the works as a whole advance plaintiff’s claim.

B. *Whether Substantial Similarity of Expression Arguably Existed Under The Audience Test.*

If similarities of expression arguably existed, it remained for the panel to determine whether a lay audience would have recognized the E.T. Theme to be a version of Joy (*Berkic*, 761 F.2d at 1294; *Krofft*, 562 F.2d at 1165),¹⁶ that is, whether a lay audience would reasonably have concluded that E.T. would satisfy the demand for Joy. *Fisher v. Dees*, 794 F.2d 432, 438 (9th Cir. 1986) (a “fair use” decision rendered while this case was under submission).

¹⁴ Actually, Baxter’s claim that the 8-note “E.T. Theme” was copied from the second of three themes in “Joy”, Baxter Op. Br. 15, see note 10, *supra*, was the only articulated basis for this suit. The real gist of his argument was that the Court should modify *Krofft* to allow expert testimony to replace the audience test and that defendants’ assumption of access *arguendo* lowered the standard of copyrightability. Baxter Op. Br. 23-34, Reply Br. 14-25. But see note 18, *infra*.

¹⁵ Of course, Baxter’s “claim” is irrelevant unless it is supported by the record. *Celotex Corp.*, 91 L.Ed. 2d at 275. If this comment means that defendants’ summary judgment must be reversed because defendants have failed to negate arguable infringement of other aspects of plaintiff’s song, the panel’s comment directly contradicts the rule in *Celotex* that the moving party does not bear the burden of disproving a case that the plaintiff has not made.

¹⁶ This is the so-called “audience test”, which is an integral part of the intrinsic test at issue here. *Krofft*, 562 F.2d at 1165.

Although making reference to the lay audience test (Op. at 7 n.2) the panel does not seem to apply it. Instead it analyzes the case:

1. by relying upon defendant's concession of access¹⁷ to lower the quantum of proof required to find substantial similarity of expression (Op. at 10).¹⁸

¹⁷ Although defendants deny access and copying, they conceded access *arguendo* for sake of the motion, and thus did not respond to plaintiff's claims of access—which the Court recites and relies upon at length (Op. at 4, 10). Defendants objected to any consideration of plaintiff's expert's testimony or special tapes; the panel seems to have acknowledged that such evidence was improper to the issues here. Op. at 7 n.2.

¹⁸ This serious error could have grave consequences as law of the case if not corrected on rehearing. Because access and similarities may raise an inference that one work is *derived* from another the panel reasons that access bears on the question whether *expression* is involved and whether that which was derived was substantial. The panel is apparently misled by the fact that "substantial similarity" in two different senses is a part of two different inquiries about *derivation* and *infringement*. "Substantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement." *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3rd Cir. 1975). The panel's use of the Inverse Ratio Rule was expressly rejected in the Second Circuit. *Arc Music Corp. v. Lee*, 296 F.2d 186, 187-88 (1961). The *Krofft* decision cited by the panel does not support its conclusion. In *Krofft*, the so-called Inverse Ratio Rule was applied *after* substantial similarity of expression was determined without reliance upon access or the Rule; access was later said to raise an inference that the similarities derived from *copying*. 562 F.2d at 1172. Confusingly, the panel's footnote 3 shifts ground again by stating the "no amount of access will suffice to show *copying* if similarities are found to be absent." "*Copying*" is not the issue in this case; it was conceded for purpose of the motion. The issue is whether what was taken was "*expression*" and whether it was sufficiently

(Continued on following page)

2. by applying the wrong test for summary judgment (Part III *infra*);

3. by creating a new burden on defendants to prove that an "absence of similarities" is "patent". (Op. at 9);¹⁹

4. by suggesting that "no bright line rule exists as to what quantum of similarity" constitutes infringement, because relatively small takings may be substantial if qualitatively important (Op. at 10);²⁰

No "bright lines" existed in the *Jason*, *Berkic*, *Litchfield* or *See* decisions either, but that did not prevent this Court from affirming summary judgments, while acknowledging the existence of some similarities.

(Continued from previous page)

"substantial" arguably to constitute infringement. No amount of access helps answer this question. This Court has affirmed summary judgment for lack of substantial similarity of expression, even where access and some similarities were assumed or proved in *Berkic*, *Litchfield*, *See* and *Jason* (alternative holding). Moreover, a new rule that would raise an inference of unlawful copying from "access" would contradict copyright policy that encourages subsequent authors to use the unprotectible ideas in prior works, and would raise First Amendment issues. *Lansberg*, 736 F.2d at 488.

¹⁹ As authority for this proposition (Op. at 9), the Opinion paraphrases and cites *Arnstein*, which concluded that summary judgment might be possible only if the contesting works were "Bolero" and "When Irish Eyes Are Smiling".

²⁰ This calculus is circular unless meaning is given to qualitative importance. The audience test as applied in *Berkic* and *Litchfield* provides that direction; the question is whether an audience would reasonably recognize one work to be a version of the other. See also, *Fisher v. Dees*, 794 F.2d 432, 438 (9th Cir. 1986) (fair use depends on whether one work serves the demand for the other).

III. THE OPINION FAILS TO FOLLOW THE PROPER TESTS FOR SUMMARY JUDGMENT ESTABLISHED BY THE SUPREME COURT, OTHER PANELS OF THIS CIRCUIT AND OTHER CIRCUIT COURTS

The rules for summary judgment have been changing for the past several years, in copyright and other cases. For many years, an anti-summary judgment bias existed, exemplified by the copyright infringement decision in *Arnstein v. Porter*, 154 F.2d 464, 469 (2d Cir. 1946), which held that summary judgment was disfavored and unavailable where the "slightest doubt" as to a factual dispute existed. As a result, no decision of this Court affirmed a summary judgment for lack of substantial similarity of expression until *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982). However, since the 1963 amendment to Federal Rule of Civil Procedure 56(e), *Arnstein* and its progeny are "mere mementos of law gone by" on the procedural standard. 6 Pt.2 *Moore's Federal Practice* ¶56.17[14] at 56-798 (2d ed. 1985)²¹

In *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327 (9th Cir. 1983), Judge Tang's original slip opinion reversed a summary judgment based on lack of substantial similarity, citing *Arnstein* and its progeny, *Goodson-Todman* and *Morrissey*, and making an *Arnstein*-like statement that summary judgment in copyright infringement cases is disfavored. After defendants' petition for rehearing in *Twentieth* pointed out that the panel

²¹ This Court noted *Arnstein's* demise as a standard for summary judgment in *Krofft*, 562 F.2d at 1165 (1977) and again in *See v. Durang*, 711 F.2d 141, 143 (1983).

was relying on the discredited *Arnstein* rule, the panel simply struck the references to the *Arnstein*, *Goodson-Todman* and *Morrissey* decisions, inserting instead a reference to the *Krofft* opinion²², but leaving intact the anti-summary judgment language of *Arnstein* and its progeny.

While the petition for rehearing in *Twentieth* was pending, another panel, in *See v. Durang*, 711 F.2d 141, 142 (9th Cir. 1983), noted *Arnstein's* demise and held:

no special standard is applied in determining whether summary judgment is appropriate on the issue of substantial similarity of expression in a copyright case.

Later decisions of this Court had to distinguish those aspects of *Twentieth* hostile to summary judgments: in *Litchfield* (1984), 736 F.2d at 1356, the Court disapproved the use of lists of similarities (used in *Twentieth*) to create a triable issue of fact of substantial similarity of expression; in *Berkic* (1985), 761 F.2d at 1292, the Court had to explain the earlier statement (in *Litchfield*, copied from *Twentieth*), that summary judgment is "disfavored" in copyright infringement suits because substantial similarity involves a "close issue of fact."

The Opinion reinstates *Arnstein* in holding that "since substantial similarity is usually an extremely close issue of fact, summary judgment is *disfavored* on that issue as a general rule." Op. at 9 (emphasis added).

While this case was under submission the Supreme Court rendered a significant decision regarding summary judgment in *Celotex*, 106 S.Ct. 2548 (1986). Clarifying

²² See Appendix 1; *Krofft* did not involve summary judgment.

the 1963 amendment to Rule 56 and later decisions, the Court concluded:

1. summary judgment is not a disfavored procedure;
2. the moving party need not show the absence of a genuine issue of material fact with respect to an issue on which the non-moving party bears the burden of proof; and

3. where the non-moving party fails to sustain his burden of proof, summary judgment is mandated. 91 L.Ed. 2d at 265-66.

The panel's Opinion reinstates *Arnstein's* "slightest doubt" rule in direct conflict with *Celotex* and *See v. Durang*:

1. It regards a summary judgment as "disfavored." (Op. at 9)²³

2. It implies that defendants had and failed to carry a burden of disproving that similarities other than a 4- or 6-note segment were arguably infringing. (Op. at 11).

3. It shifts to defendants the burden of proving that "the absence of similarities is so patent as to warrant summary judgment. See *Arnstein*, 154 F.2d at 473." (Op. at 9) See note 8, *supra*.

²³ It justifies this conclusion by reasoning that the similarity issue is "usually an extremely close issue of fact". Opinion at 9 (emphasis added). But, because the idea/expression dichotomy involves policy issues, *Krofft*, 562 F.2d at 1163, a mixed issue of fact and law exists. See *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986) ("fair use" a mixed issue). Moreover, since no dispute exists in the record about the contents of the works, none of the other anti-summary judgment admonitions about "credibility", "weighing evidence" or drawing inferences is relevant here.

4. It requires defendants to show that a "bright line exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity." (Op. at 10). *Contra: Jason, Berkic, Litchfield and See.*

5. It requires defendants to show that the two works "are so dissimilar that reasonable minds could not differ as to a lack of substantial similarity between them." (Op. at 11).

IV. CONCLUSION

This is a simple but an important case. A review of the two works (less than five total minutes on cassette tapes in Appendix 2) can lead to only one conclusion: The similarity of 4- or 6-notes, as used in this case, occurs at the level of idea, not expression. Alternatively, no lay audience could reasonably believe that the E.T. Theme satisfies the demand of the consuming public for plaintiff's "Joy." Plaintiff thus has not shown an arguably substantial taking of protectible expression and summary judgment is mandated.

For all the foregoing reasons, a rehearing, *en banc* if necessary, should be granted.

DATED: March 18, 1978

/s/ Ronald S. Rosen
RONALD S. ROSEN of
SILVERBERG, ROSEN,
LEON & BEHR

Attorneys for the
Defendant-Appellee,
JOHN T. WILLIAMS

/s/ Louis P. Petrich
LOUIS P. PETRICH of
LEOPOLD, PETRICH &
SMITH

Attorneys for Defendants-
Appellees, MCA INC.,
UNIVERSAL CITY STU-
DIOS, INC., MUSIC CORP.
OF AMERICA, MCA REC-
ORDS, INC., MERCHANDIS-
ING CORP. OF AMERICA

CONSTITUTIONAL PROVISIONS,
STATUTES, AND RULES INVOLVED

Article I, section 8 of the Constitution provides that:

The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

The First Amendment to the Constitution provides that:

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.

Section 102(a) of the Copyright Act of 1976, 17 U.S.C. § 102(b), provides:

Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression . . . Works of authorship include the following categories:

. . .

(2) musical works, including any accompanying words;

Section 102(b) of the Copyright Act of 1976, 17 U.S.C. § 102(b), provides:

In no case does copyright protection for an original work of authorship extend to any idea. . . [or] concept. . . regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Federal Rule of Civil Procedure No. 56

Rule 56. Summary Judgment.

(a) **FOR CLAIMANT.** A party seeking to recover upon a claim, counterclaim, or cross-claim or to obtain a declaratory judgment may, at any time after the expiration of 20 days from the commencement of the action or after service of a motion for summary judgment by the adverse party, move with or without supporting affidavits for a summary judgment in his favor upon all or any part thereof.

(b) **FOR DEFENDING PARTY.** A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.

(c) **MOTION AND PROCEEDINGS THEREON.** The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages.

(d) **CASE NOT FULLY ADJUDICATED ON MOTION.** If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court at the hearing of the motion, by examining

the pleadings and the evidence before it and by interrogating counsel, shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, including the extent to which the amount of damages or other relief is not in controversy, and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

(e) **FORM OF AFFIDAVITS; FURTHER TESTIMONY; DEFENSE REQUIRED.** Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of his pleading, but his response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If he does not so respond, summary judgment, if appropriate, shall be entered against him.

(f) **WHEN AFFIDAVITS ARE UNAVAILABLE.** Should it appear from the affidavits of a party opposing the motion that he cannot for reasons stated present by affidavit facts

essential to justify his opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

(g) **AFFIDAVITS MADE IN BAD FAITH.** Should it appear to the satisfaction of the court at any time that any of the affidavits presented pursuant to this rule are presented in bad faith or solely for the purpose of delay, the court shall forthwith order the party employing them to pay to the other party the amount of the reasonable expenses which the filing of the affidavits caused him to incur, including reasonable attorney's fees, and any offending party or attorney may be adjudged guilty of contempt.

IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

TWENTIETH CENTURY-FOX)	No. CA 80-5868
FILM CORPORATION, ET AL.,)	
)	D.C. No.
Plaintiffs-Appellants,)	CV-78-2437
)	
vs.)	ORDER
)	AMENDING
MCA, INC., et al.,)	OPINION
)	
Defendants-Appellees.)	(Filed May 6, 1983)

Before: CHAMBERS, GOODWIN and TANG, Circuit
Judges.

The opinion filed January 11, 1983, is amended as follows: (1) Page 195 of Slip Op.—In the 2nd column, following the 1st sentence of the 1st paragraph (ending with “. . . idea was copied.”), insert the following citation:

Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977).

(2) Page 195 of Slip Op.—Following the sentence: “At a minimum, it is a close enough question that it should be resolved by way of a trial.”—delete the signal “See” and the three citations (*Goodson-Todman*, *Morrissey*, and *Arnstein*).

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES—GENERAL

Case No. CV 87-1064 HLH

Date June 22, 1987

Title INTERACTION RESEARCH, INC. V. AIR CAL,
INC.

DOCKET ENTRY

PRESENT:

HON. Harry L. Hupp, JUDGE

Robert Bolton

Deputy Clerk

Stella Cordova

Court Reporter

ATTORNEYS PRESENT FOR PLAINTIFFS:

Philip A. Putman

ATTORNEYS PRESENT FOR DEFENDANTS:

David Nimmer

Richard A. Sherman

PROCEEDINGS: Motion to Dismiss, or in the Alternative, Summary Judgment

ORDER (also, if applicable, findings and memorandum opinion):

Defendant's motion to dismiss or, in the alternative, for summary judgment is denied. Defendant has 20 days to answer.

At least parts of plaintiff's product could reasonably be said to be so close to comparable parts of defendant's product that the court cannot say that a reasonable jury could not find substantial similarity of expression. The court has in mind that a limited number of ideas must be expressed and that there must be a limited number of ways of expressing the ideas. In addition, there are a substantial number of differences in the expression of the ideas so that a jury could clearly and unequivocally find, if they chose to do so, no substantial similarity. The question, though,

is whether the jury could find the requisite substantial similarity in at least parts of the expressions. By a recent reversal (*Baxter v. MCA, Inc.* (9th Cir. 1987) — F.2d — (#84-6522, 3/5/87)), the court's attention has been forcefully drawn to the necessity of letting the jury decide the question if it is remotely arguable. (Contra, apparently, *Frybarger v. IBM* (9th Cir. 1987) — F.2d — (3/10/87, #86-2004)).

Plaintiff please pay attention to your exhibits next time; items different than the ones described were attached and items listed were not attached at all.

Initials of Deputy Clerk RB

NOT FOR PUBLICATION
UNITED STATES COURTS OF APPEALS
FOR THE NINTH CIRCUIT

GENE THOMPSON,)	
)	Nos. 86-6185
Plaintiff-Appellant,)	86-6505
)	
v.)	DC. No.
)	CV 85-1583 JMI (Kx)
LIONEL RICHIE, et al.,)	
)	MEMORANDUM*
Defendants-Appellees.)	
<hr/>		

Appeal from the United States District Court
for the Central District of California
James M. Ideman, District Judge, Presiding
Argued and Submitted: April 6, 1987
Pasadena, California

June 11, 1987

Before: ANDERSON, SKOPIL, and REINHARDT,
Circuit Judges.

Gene Thompson composed the music and lyrics to a song he entitled "Somebody's Got to Love Her." Thompson's song was copyrighted in 1980, with a certificate of registration, in the form of lyrics and a sound recording, but not as sheet music.

Lional Richie composed the songs "Stuck on You" and "Hello" in 1983. They became widely distributed and

*This disposition is not appropriate for publication and may not be cited to or by the courts of this circuit except as provided by 9th Cir. R. 21.

very successful as songs on Richie's phonograph record "Can't Slow Down."

In 1985, Thompson brought a copyright infringement action against Richie, alleging "Stuck on You" and "Hello" infringed his copyright to "Somebody's Got to Love Her." Richie moved for summary judgment on the ground there was no substantial similarity between the works. For purposes of Richie's summary judgment motion, he conceded access to Thompson's work. Thompson opposed the motion and withdrew his claim that the song "Hello" infringed his song. He also submitted the declaration of Dr. Robert Winter, a music expert, who examined and compared "Stuck on You" with "Somebody's Got to Love Her" and found similarities in the melody, harmony and rhythm between the two songs.

The district court reviewed the audio cassettes and lyric sheets of "Stuck on You" and "Somebody's Got to Love Her" and found the works were not of substantial similarity of expression or ideas. The court concluded that the ordinary, average lay person could not find the works substantially similar as a matter of law. Accordingly, the district court granted Richie's motion for summary judgment and for costs and attorney's fees of \$34,307.65.

Thompson appeals the grant of summary judgment and the fees award. As to each, we reverse.

We review *de novo* a summary judgment ruling that there is no substantial similarity between two works in a copyright suit. *Frybarger v. IBM*, 812 F.2d 525, 528 (9th Cir. 1987). Since the plaintiff in a copyright suit bears the burden of showing that the works are substantially similar, Thompson must show some genuine issue of material

fact exists as to whether a reasonable jury could conclude the works are substantially similar if he is to avoid affirmance of summary judgment. *Id.* at 529. We believe he has done so.

To establish a claim for copyright infringement, Thompson has to show: (1) he owns the copyright of the work, and (2) "copying" of protectible expression by Richie. *See Baxter v. MCA*, 812 F.2d 421, 423 (9th Cir. 1987), *as amended*, slip op. (9th Cir. May 11, 1987). Since direct evidence of copying is rarely available, Thompson can establish copying by circumstantial evidence of: (1) access to the song prior to creation of Richie's song, and (2) substantial similarity of general ideas and expression between the two works. *Baxter*, 812 F.2d at 423; *Frybarger*, 812 F.2d at 529.

Thompson's ownership of the copyright to "Somebody's Got to Love Her" is undisputed. Also, for purposes of summary judgment, Richie conceded access to Thompson's work. Therefore, the only question is whether the district court's finding that the works were not substantially similar can sustain the grant of summary judgment.

Under substantial similarity we must determine whether the works are substantially similar (1) in their general ideas (extrinsic test), and (2) in their general expression (intrinsic test). *Berkie v. Crichton*, 761 F.2d 1289, 1292 (9th Cir.), *cert. denied*, 106 S.Ct. 85 (1985). The extrinsic test relies on expert testimony. The intrinsic test, however, "is subjective; it depends solely 'on the response of the ordinary reasonable person.'" *Id.* (quoting *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977)). "[E]xpert

testimony . . . is inappropriate in applying the intrinsic test." *Id.* Since substantial similarity is usually an extremely close question of fact, summary judgment is disfavored. *Frybarger*, 812 F.2d at 528.

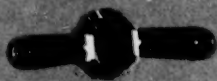
We find an issue of fact with respect to similarity of ideas. Through the use of expert opinion, Thompson attempted to show that of the twenty different pitches in the opening phrases of the two songs, nineteen were nearly identical. Such similarity was also opined in the harmony and the tempo.

Playing the tapes of both songs reveals that there is also an issue of fact as to similarity of expression.

Since there is "no bright line . . . as to what quantum of similarity is permitted before crossing into the realm of substantial similarity," *Baxter*, 812 F.2d at 425, we feel the ears of the court must yield to the ears of the jurors. While the two songs appear to have little similarity, we cannot say they are so dissimilar as to justify summary judgment. *See Frybarger*, 812 F.2d at 528 (since substantial similarity is usually an extremely close question of fact, summary judgment is disfavored).

The district court's grant of summary judgment is reversed. In light of our finding of reversal, it follows that the district court erred in finding Thompson's suit frivolous. Therefore, the award of costs and attorney's fees is also reversed.

REVERSED and REMANDED.



32K-55W
6X9